

### REMARKS

The Applicant has studied the Office Action dated December 11, 2003. Reexamination and reconsideration of this application is requested. By this response, claims 1-27, 33, 34, 37, 38, and 42 are pending in the application and are presented for the Examiner's review and consideration. Claims 1-4, 6-12, 15, 19, 23, 33, 37-38 have been amended and claims 28-32, 35, 36, 39-41, 43, and 44 have been cancelled. It is submitted that the application is in condition for allowance. Reconsideration and allowance of the pending claims in view of the following remarks are respectfully requested. No new matter has been added. In the Office Action, the Examiner:

- objected to the abstract because the abstract contains more than 150 words;
- rejected claims 23-36 under 35 U.S.C. § 101;
- rejected claims 1-8, 15-34, and 37-44 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,249,809, to Bro ("Bro") in view of U.S. Patent No. 6,283,761, to Joao ("Joao"); rejected claims 9-11, 35 and 36 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,249,809, to Bro ("Bro") in view of U.S. Patent No. 6,283,761, to Joao ("Joao") and further view of U.S. Pat. No. 5,935,060 to Iliff ("Iliff"); and
- rejected claims 12-14 were rejected under 35 U.S.C. §103(a) as being unpatentable over Bro and Joao as applied to claim 1 above, and further in view of Lade, Diane, "Cyber Docs people with a wide range of medical problem are finding support online from doctors and other patients themselves" ("Cyber Docs").

### Objection to the Specification

As noted above, the Examiner objected to the abstract because the abstract contains more the 150 words. Accordingly, Applicant has provided a substitute abstract and requests that it be entered. No new matter has been added. In light of the substitute abstract, Applicant respectfully requests withdrawal of the objection to the abstract.

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Claim Rejections under 35 U.S.C. § 101

As noted above, the Examiner rejected claims 23-36 under 35 U.S.C. §101 because the invention is directed to non-statutory subject matter. The Examiner states that the basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

In the present case, the instant claims fail to recite the use of any type of technology (e.g. computer system) within the recited steps of the claimed methods of providing support or care to persons undergoing a surgical procedure. The recited steps constitute an idea on how to carry out the steps for a pre and post operative support and care procedure. The Examiner suggests that Applicant include language in some of the body of the claim limitations of the independent claims to indicate that some means of technology (i.e. computer or data processing means) is used to carry out the method.

As an initial matter, claims 28-32, 35, and 36 have been cancelled rendering the rejection of these claims moot.

As suggested by the Examiner, claims 23 and 33 have been amended to include a data processing means (e.g. web server) with information regarding the persons which is stored in a database maintained on a system representative terminal. The amendment to claims 23 and 33 recites the use of a technology in the performances of the methods.

In light of the foregoing, independent claims 23 and 33 are respectfully submitted to be directed to a statutory subject matter. As claims 24-27 depend from amended claim 23 and claim 34 depends from amended claim 33 and necessarily include all the elements of their respective base claim, Applicant hereby respectfully submits that these claims are also directed to statutory subject matter at least for the same reasons.

Claim Rejections under 35 U.S.C. § 103(a) Bro in view of Joao

As noted above, the Examiner rejected claims 1-8, 15-34, and 37-44 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,249,809, to Bro ("Bro") in view of U.S. Patent No. 6,283,761, to Joao ("Joao"). Independent claims 1, 19, 37 and 38 have been amended to distinguish over Bro taken alone and/or in view of Joao.

As an initial matter, claims 39-41, 43, and 44 have been cancelled rendering the rejection of these claims moot.

In the office action, the Examiner states:

"Bro discloses a system for providing support and care to persons considering or undergoing a medical procedure (see abstract), comprising means for receiving, processing and providing information regarding said persons to and from said persons and said medical practitioner (see Fig. 2 and col. 3, lines 29-39), means for providing information and positive reinforcement to said persons regarding said medical procedure being considered or undergone (i.e. motivational and/or information messages) (col. 3, lines 29-39), and means for receiving, processing and delivering care orders and medicaments from said medical practitioners to said persons (col. 7, lines 34-38, col. 8, lines 25-29, col. 9, lines 5-21 and col. 10, lines 12-20). Bro does not explicitly disclose means for scheduling and coordinating medical consultations and said medical procedure between said persons and said medical practitioners.

However, Joao discloses means for scheduling and coordinating medical consultations and said medical procedure between said persons and said medical practitioners (col. 32, lines 47-52). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include means for scheduling and coordinating medical consultations and said medical procedure between said persons and said medical practitioners as discloses Joao within the Bro system for the motivation of providing improved health care quality and efficient information collection." (col. 2, lines 46-54).

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable

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expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaack*, 947 F.2d 488 (Fed. Cir. 1991); see MPEP § 2143. If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988); see MPEP § 2143- § 2143.03.

The initial burden is on the Examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

Bro discloses an automated and interactive system that allows a physician, counselor, teacher, employer or trainer to produce and send information, messages, and/or questions to, or to elicit responses or information from, a client, patient, employee or student. (See Bro abstract) The automated and interactive system of this invention is designed to be used by doctors, managed care organizations, pharmacists, pharmacy benefit managers, pharmaceutical manufacturers, psychologists, counselors, teachers, managers, administrators, peers or other trainers to provide motivational and/or informational messages and/or questions to patients, employees, students, etc. (collectively referred to as clients) needing information, having behavioral, instructional, volitional or motivational problems or from whom responses to inquiries of any nature are required. (Col. 3, lines 29-39).

The improvement to Applicant's previously disclosed system includes a visual message-waiting indicator, visual icon, or screen interface (which may also have an audio signal therewith), associated with the client's telephone, television or personal computer. (Col. 4, ln. 64 -col. 5, ln. 1). Box 10 also has a programmable speed dial button 18, which is programmed to dial directly into the remote computer system. (Col.

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5, Ins. 64-66). Once the remote computer is accessed, a menu of choice for interconnection to various services and information can be provided. (Col 6, lines 1-3).

As such, Bro discloses an automated and interactive system which is used to provide direct interaction between a physician and a patient. The system includes a device which allows a patient to connect to a remote computer system. The patient can retrieve messages, information, or respond to inquires provided by the physician. As stated by the Examiner, Bro does not disclose scheduling and coordinating medical consultations and medical procedures. Additionally, Bros does not disclose a third party provider acting as an intermediary between the physician and patient. The Examiner goes on to combine Bro with Joao.<sup>1</sup>

As noted above, the Examiner states Joao discloses means for scheduling and coordinating medical consultations and said medical procedure between said persons and said medical practitioners. (col. 32, lines 47-52).

Joao discloses a central processing computer 10 which also includes a database(s) 10H which contains data and information pertaining to patients, providers, payers and intermediaries who or which are serviced by the present invention. (Col. 16, Ins. 33 - 36). The invention can be utilized to schedule appointments. (Col. 32, Ins. 47-48). Provider scheduling information can be stored in the database 10H. (Col. 32, Ins. 55-56). The patient accesses the central processing computer 10 and requests the schedule or schedules of a provider or a number of providers. (Col. 32, Ins. 58-60). The patient can select the appointment he or she wishes to make. (Col. 32, Ins. 62-63). The central processing computer 10 will update the provider's schedule to reflect the new appointment. (Col. 32, Ins. 66-67).

As such, Joao discloses a central processing computer having a database which can be directly accessed by the patient. The data base contains a provider schedule such that the patient can select and schedule their own appointments. The data base will

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<sup>1</sup> Applicant makes no statement on whether such combination is even proper.

then be updated to reflect the scheduled appointment. Joao does not disclose a third party provider acting as an intermediary between the physician and patient.

In sum, neither Bro nor Joao discloses a third party provider acting as an intermediary between the physician and patient.

In contrast, one embodiment of the present invention relates to a third party provider acting as an intermediary between patients and medical practitioners. As set forth in the specification, the attendant can, when the user requests, assist with the selection 2.7 of a medical practitioner and coordinate scheduling of an initial consultation with the selected medical practitioner, and thereafter transition the patient to a pre and post operative care system and method. (See e.g. ¶0069) If the patient prospect has scheduled an initial appointment with the selected medical practitioner, the system representative contacts 5.1 the patient at least 24 hours prior to the scheduled appointment to confirm the appointment and to answer any questions that the patient may have. (See e.g. ¶0077) The system representative inputs a record of the patient prospect's concerns and questions 5.3 and the system generates an updated patient profile form 101 indicating the patient's personal, demographic, medical and credit approval information as well as the patient's noted questions and concerns, which is then transmitted 5.4 to the medical practitioner at least 24 hours prior to the appointment. (Id.)

Similarly, if the patient prospect has scheduled a medical procedure date, the medical practitioner will also transmit the prescribed pre-operative medicament and care regime to the system. (See e.g. ¶0079) The system representative verifies 8.1 delivery of the pre-operative kit by contacting the patient and discusses with the patient the outcome of the appointment as well as what to expect through the procedure. (See e.g. ¶0081). In an exemplary time interval of 10 weeks through 3 weeks prior to the scheduled medical procedure date, the system representative calls the patient each week 11.1 to answer any questions and provide positive reinforcement, and inputs patient issues and concerns into the patient profile form 101 and/or patient summary 102. (See e.g.

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¶0084). The updated patient profile form 101 and patient summary 102 is transmitted on an as needed basis to the medical practitioner, and comments from the medical practitioner are noted thereon. (*Id.*)

In order to clarify the present invention, claim 1 now recites a system for providing support and care to persons considering or undergoing a medical procedure. The system includes a means for a third party provider to receive, process, and provide information regarding the persons to and from the persons and medical practitioners. Similarly, means for the third party provider to; provide information and positive reinforcement to the persons regarding said medical procedure being considered or undergone; to schedule and coordinate medical consultations and said medical procedure between said persons and said medical practitioners, and to receive, process, and deliver care orders and medicaments from said medical practitioners to said persons.

Applicant respectfully submits that the invention as claimed in claim 1 is not taught or suggested by Bro or Joao. Specifically, Bro discloses an automated and interactive system which is used to provide direct interaction between a physician and a patient, where the patient directly connects to a remote computer system to retrieve messages, information, or respond to inquiries provided by the physician. Joao does not disclose a third party provider scheduling and coordinating medical consultations and said medical procedure between said persons and said medical practitioners. Joao discloses only that the patient can select and schedule their own appointments. There is no discussion or suggestion of a third party provider scheduling and coordinating medical consultations and said medical procedure between said persons and said medical practitioners. As such, neither of the two components are capable of radially increasing the cross sectional area of the passage Bro nor Joao does disclose all of the elements of claim 1.

Moreover, the Federal Circuit has consistently held that when a §103 rejection is based upon a modification of a reference that destroys the intent, purpose or function of the invention disclosed in the reference, such a proposed modification is not proper and the *prima facie* case of obviousness can not be properly made. See *In re Gordon*, 733

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F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Here the intent, purpose and function of Bro taken alone or in view of Joao is direct interaction between a medical practitioner and a patient, in contrast the intent and purpose of the present invention is a third party acting as an intermediary. The present invention assists with the selection of the medical practitioner and the scheduling of initial consultations. Unlike the prior art systems, the patient in the present invention does not have a specific medical practitioner established. This combination of Bro and Joao, as suggested by the Examiner, destroys the intent and purpose of direct contact between medical practitioner and patient. Accordingly, the present invention is distinguishable over Bro taken alone or in view of Joao for this reason as well.

Continuing further, when there is no suggestion or teaching in the prior art for a third party intermediary the suggestion cannot come from the Applicant's own specification. The Federal Circuit has repeatedly warned against using the Applicant's disclosure as a blueprint to reconstruct the claimed invention out of isolated teachings of the prior art. See MPEP §2143 and Grain Processing Corp. v. American Maize-Products, 840 F.2d 902, 907, 5 USPQ2d 1788 1792 (Fed. Cir. 1988) and In re Fitch, 972 F.2d 160, 12 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). The prior art reference Bro and Joao do not even suggest, teach nor mention a third party intermediary.

In light of the foregoing, independent claims 1, 37, and 38 are respectfully submitted to be patentable over Bro in view of Joao. As claims 2-18 depend from amended claim 1 and necessarily include all the elements of their respective base claim, Applicant hereby respectfully submits that these claims are also patentable over the cited references at least for the same reasons and the Examiner's rejection should be withdrawn.

Applicant respectfully submits that the invention as claimed in amended claim 19 is not taught or suggested by Bro or Joao. Specifically, Bro discloses an automated and interactive system which is used to provide direct interaction between a physician and a patient, where the patient directly connects to a remote computer system to retrieve messages, information, or respond to inquiries provided by the physician. Joao discloses only that the patient can select and schedule their own appointments. There is no discussion or suggestion of a third party provider system which receives,

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processes, and provides information regarding patients to and from the patients and the medical practitioner and a medical practitioner system to receive, process, and provide information regarding said persons to and from said third party provider.

In light of the foregoing, independent claim 19 is respectfully submitted to be patentable over Bro in view of Joao. As claims 20-22 depend from amended claim 19, they necessarily include all the elements of their respective base claim. Applicant hereby respectfully submits that these claims are also patentable over the cited references at least for the same reasons.

Similarly, independent claims 23, 33, 37 and 38 have been amended to recite similar elements as recited in amended claim 1. Specifically, claims 23, 33, 37, and 38 each contain the element of a third party provider scheduling and coordinating medical consultations and said medical procedure between said persons and said medical practitioners. For the same reasons as set forth above, Applicant respectfully submits that claims 23, 33, 37, and 38 are patentable over Bro in view of Joao. As claims 20-22 depend from amended claim 19, claims 24-27 and 42 depend from amended claim 23, and claim 34 depends from amended claim 33 and they necessarily include all the elements of their respective base claims, Applicant hereby respectfully submits that these claims are also patentable over the cited references at least for the same reasons.

Claim rejections under 35 U.S.C. § 103(a) Bro in view of Joao and Iliff

As noted above, the Examiner rejected claims 9-11, 35 and 36 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,249,809, to Bro ("Bro") in view of U.S. Patent No. 6,283,761, to Joao ("Joao") and further view of U.S. Pat. No. 5,935,060 to Iliff ("Iliff"). Independent claims 1 has been amended to distinguish over Bro taken alone and/or in view of Joao and/or in further view of Iliff.

As an initial matter, claims 35 and 36 have been cancelled rendering the rejection of these claims moot.

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Further as described in the section above entitled "35 U.S.C. § 103(a) Bro in view of Joao", independent claim 1 has been amended to recite a third party intermediary between the medical practitioner and patient. The Examiner goes on to combine Bro and Joao with Iliff.<sup>2</sup> Iliff is silent on a "third party provider" acting as an intermediary.

In light of the foregoing, independent claim 1 is respectfully submitted to be patentable over Bro taken alone and/or in view of Joao and/or in further view of Iliff. As claims 9-11 depend from amended claim 1 they necessarily include all the elements of their respective base claim, Applicant hereby respectfully submits that these claims are also patentable over the cited references at least for the same reasons and the Examiner's rejection should be withdrawn.

Claim rejections under 35 U.S.C. § 103(a) Bro in view of Joao and Iliff and Cyber Docs.

As noted above, the Examiner rejected claims 12-14 under 35 U.S.C. §103(a) as being unpatentable over Bro and Joao as applied to claim 1 above, and further in view of Lade, Diane, "Cyber Docs people with a wide range of medical problem are finding support online from doctors and other patients themselves" ("Cyber Docs"). Independent claim 1 has been amended to distinguish over Bro taken alone and/or in view of Joao and/or in further view of Iliff.

As described in the section above entitled "35 U.S.C. § 103(a) Bro In view of Joao", independent claim 1 has been amended to recite a third party intermediary between the medical practitioner and patient. The Examiner goes on to combine Bro and Joao with Iliff and Cyber Doc.<sup>3</sup> Cyber Doc is silent on a "third party provider" acting as an intermediary.

In light of the foregoing, independent claim 1 is respectfully submitted to be patentable over Bro taken alone and/or in view of Joao and/or in further view of Iliff and/or Cyber Docs. As claims 12-14 depend from amended claim 1, they necessarily include all the elements of their respective base claim. Applicant hereby respectfully submits that these

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<sup>2</sup> Applicant makes no statement whether such combination is even proper.

<sup>3</sup> Applicant makes no statement whether such combination is even proper.

claims are also patentable over the cited references at least for the same reasons and the Examiner's rejection should be withdrawn.

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**CONCLUSION**

The remaining cited references have been reviewed and are not believed to affect the patentability of the claims as amended.

In this Response, Applicant has amended certain claims. In light of the Office Action, Applicant believes these amendments serve a useful clarification purpose, and are desirable for clarification purposes, independent of patentability. Accordingly, Applicant respectfully submits that the claim amendments do not limit the range of any permissible equivalents.

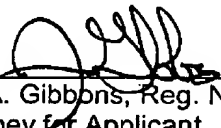
Applicant acknowledges the continuing duty of candor and good faith in the disclosure of information known to be material to the examination of this application. In accordance with 37 CFR §1.56, all such information is dutifully made of record. The foreseeable equivalents of any territory surrendered by amendment is limited to the territory taught by the information of record. No other territory afforded by the doctrine of equivalents is knowingly surrendered and everything else is unforeseeable at the time of this amendment by the Applicant and his attorneys.

Applicant respectfully submits that all of the grounds for rejection stated in the Examiner's Office Action have been overcome, and that all claims in the application are allowable. No new matter has been added. It is believed that the application is now in condition for allowance, which allowance is respectfully requested.

**PLEASE CALL** the undersigned if it would expedite the prosecution of this application.

Respectfully submitted,

Date: April 4, 2004

By:   
Jon A. Gibbons, Reg. No. 37, 333  
Attorney for Applicant  
FLEIT, KAIN, GIBBONS,  
GUTMAN, BONGINI, & BIANCO P.L.  
551 N.W. 77th Street, Suite 111  
Boca Raton, FL33487  
Tel(561) 989-9811  
Fax (561) 989-9812

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